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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,393	10/09/2003	Susann Marie Keohane	AUS920030735US1	8393
43307	7590	07/17/2006	EXAMINER	
IBM CORP (AP) C/O AMY PATILLO P. O. BOX 161327 AUSTIN, TX 78716			MITCHELL, KEITH OLINGA	
			ART UNIT	PAPER NUMBER
			2195	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/682,393

Applicant(s)

KEOHANE ET AL.

Examiner

Keith O. Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/09/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/09/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed on 10/09/2003 has been considered by the Examiner.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 13-18 are rejected under 35 U.S.C 101 as being unpatentable because the claimed invention is directed to non-statutory subject matter. Claims 13-18 are all directed to a recording medium which includes transmission media (signals) such as acoustic or light waves (para. 29) which are nonstatutory per se. Please refer to United States Patent and Trademark Office OG Notices: 22 November 2005" Annex IV for further guidance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 6-10, 12-16, 18 and 20 are rejected under 35 U.S.C 102 (b) as being anticipated by US Publication No. 20040049696 to Baker et al hereafter referred to as Baker.

With respect to claim 1, Baker discloses a method for controlling future recipients of an email, comprising: receiving an email with at least one pre-selected future recipient at a computer system accessible to a primary recipient of said email (para. 36), wherein said at least one pre-selected future recipient is distinguishable from a sender of said email (para. 36); displaying said received email; and responsive to said primary recipient electing to respond to said email, automatically addressing a response email to said at least one pre-selected future recipient, such that a sender of said email controls future recipients of said email by pre-selecting said at least one fixture recipient (para. 36).

With respect to claim 2, Baker discloses the method of claim 1 for controlling future recipients of an email, further comprising: receiving an election to respond by replying to said email (para. 38).

With respect to claim 3, Baker discloses the method of claim 1 for controlling future recipients of an email, further comprising: receiving an election to respond by forwarding said email (para. 38).

With respect to claim 4, Baker discloses the method of claim 1 for controlling future recipients of an email, further comprising: automatically addressing said response email as a carbon copy to said at least one pre-selected future recipient (para. 38).

With respect to claim 6, Baker discloses the method of claim 1 for controlling future recipients of an email, further comprising: enabling said primary recipient to select additional recipients of said response email (modification of the privilege profile, para. 45).

With respect to claim 7, Baker discloses an electronic mail system, comprising: a computer system communicatively connected to a network (para. 30); means for receiving an email with at least one pre-selected future recipient at said computer system accessible to a primary recipient of said email (para. 38); means for displaying said received email (para. 38); and means responsive to said primary recipient electing to respond to said email, for automatically addressing a response email to said at least one pre-selected future recipient (para. 38).

With respect to claim 8, Baker discloses the electronic mail system of claim 7, further comprising: means for receiving an election to respond by replying to said email (para. 38).

With respect to claim 9, Baker discloses the electronic mail system of claim 7, further comprising: means for receiving an election to respond by forwarding said email (para. 38).

With respect to claim 10, Baker discloses the electronic mail system of claim 7, further comprising: means for automatically addressing said response email as a carbon copy to said at least one pre-selected future recipient (para. 38).

With respect to claim 12, Baker discloses the electronic mail system of claim 7, further comprising: means for enabling said primary recipient to select additional recipients of said response email (para. 45).

With respect to claim 13, Baker discloses a computer program product for controlling future recipients of an email, comprising: a recording medium (memory containing a program, para). 4; means, recorded on said recording medium, for accessing an email intended for a primary recipient with at least one pre-selected future recipient specified by a sender of said email (para. 4), wherein said at least one pre-selected future recipient is distinguishable from said sender of said email; means, recorded on said recording medium, for displaying said received email (email is displayed on computer shown in fig. 1); and means, recorded on said recording

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medium, for automatically addressing a response email to said at least one pre-selected future recipient, responsive to said primary recipient electing to respond to said email (para. 4).

With respect to claim 14, Baker discloses the computer program product of claim 13 for controlling future recipients of an email, further comprising: means, recorded on said recording medium, for receiving an election to respond by replying to said email. (para. 4,38).

With respect to claim 15, Baker discloses the computer program product of claim 13 for controlling future recipients of an email, further comprising: means, recorded on said recording medium, for receiving an election to respond by forwarding said email (para. 4, 38).

With respect to claim 16, Baker discloses the computer program product of claim 13 for controlling future recipients of an email, further comprising: means, recorded on said recording medium, for automatically addressing said response email as a carbon copy to said at least one pre-selected future recipient (para. 4,38).

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With respect to claim 18, Baker discloses the computer program product of claim 13 for controlling future recipients of an email, further comprising: means, recorded on said recording medium, for enabling said primary recipient to select additional recipients of said response email (para. 4,45).

With respect to claim 20, Baker discloses a method for pre-selecting future recipients of an email, comprising: detecting a composed email with at least one primary recipient; comparing said at least one primary recipient with an plurality of addresses each specified with a pre-selected future recipient; and responsive to said at least one primary recipient matching one of said plurality of addresses, automatically designating said matching pre-selected future recipients for said address in said email (para. 38).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 11 and 17 are rejected under 35 U.S.C 103 (a) as being unpatentable over Baker in view of US Publication No. 20030200263 to Goldberg hereafter referred to as Goldberg.

Baker discloses the method of claim 1 for controlling future recipients of an email but does not further anticipate hiding an actual address for said at least one pre-selected future recipient (para. 38).

Goldberg teaches a system where senders can include addresses as a blind carbon copy (bcc) where recipients do not see the addresses included as a bcc (para.5)

At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the system disclosed by Baker with that of Goldberg to have the ability to send messages where the future selected recipients are hidden.

The motivation for doing so would have been to provide a sender using Baker's system with the ability to make the future copy a private message (para. 5 of Goldberg), increasing the available message sending options for the user when additional security is required.

As concerns Claim 11, Baker as modified discloses the system the electronic mail system of claim 7, further comprising: means for hiding an actual address for said at least one pre-selected future recipient. (para. 4, 38 of Baker).

As concerns Claim 17, Baker as modified discloses the computer program product of claim 13 for controlling future recipients of an email, further comprising: means, recorded on said recording medium, for hiding an actual address for said at least one pre-selected future recipient (para. 4, 38 of Baker).

8. Claim 19 is rejected under 35 U.S.C 103 (a) as being unpatentable over Baker in view of US Publication No. 20040148356 to Bishop et al hereafter referred to as Bishop.

Baker discloses the method for enabling a sender to control future recipients of an email, comprising: responsive to a request to compose a new email (para. 38), enabling a sender of said email to designate at least one future recipient of said email (para. 38), but does not anticipate embedding said at least one future recipient in a header of said email, wherein a mail reader receiving said email is directed to address any response to said email to said at least one future recipient.

Bishop teaches the use of embedding recipient information in the message header of an electronic message (para. 40).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the system disclosed by Baker with that of Bishop to have the ability to send electronic messages with a header to include additional information.

The motivation for doing so would have been to provide a sender using Baker's system with the ability to send messages with a private messaging capability enabled so that a user can distribute and manage dissemination of sensitive information (para. 3 of Bishop).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Mitchell whose telephone number is 517-270-1134. The examiner can normally be reached on 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Susy Tsang-Foster can be reached on 571-272-1293. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KM/



SHUWANG LIU
PRIMARY EXAMINER